

Application No.: 09/484,730
Reply to Office Action of December 29, 2004
Attorney Docket No.: 0035.0001 (2000-001)

b.) Remarks

Acknowledgment of US Effective Filing Date and Priority Information

The Applicant respectfully brings to the attention of the Patent Office that Applicant has correctly claimed the benefit of the earlier filing date of provisional application 60/116,395, filed on January 19, 1999. Applicant has also correctly claimed priority to the earlier filed Israeli patent application IL129412, filed on April 13, 1999. A copy of the originally signed inventor's declaration is enclosed with this response. The first paragraph of the present application also states the relevant priority claim to the Israeli application, as well as claims the benefit of the earlier filed provisional application. The Patent Office is requested to acknowledge the priority information under 35 USC 119(a)-(d) and 35 USC 119(e).

In view of the priority information overlooked by the Patent Office, Applicant points out that the Checco patent (US 5,859,898, issued January 12, 1999) cannot be a 102(b) publication against any of the pending claims, since the Checco patent issued 6 days before the January 18, 1999 effective US filing date of the present application. Therefore, Applicant respectfully request that the Checco patent be withdrawn as a 102(b) reference.

Moreover, the Born patent (US 6,064,440), the Krishbergh patent (US 5,999,970), the Krueger patent (US 6,460,075) and the Wagner patent (US 6,335,736) all published after the effective US filing date of the present application.

Rejection under 35 USC 102(b)

The Patent Office rejected Claims 120, 121 & 134 under 102(b) as anticipated by Checco. In view of the above-presented arguments with regard to the effective filing date of the present application in the US, Checco is not a 102(b) publication against the pending Claims. Rejection under 102(b) should be withdrawn.

Application No.: 09/484,730
Reply to Office Action of December 29, 2004
Attorney Docket No.: 0035.0001 (2000-001)

Rejection under 35 USC 103(a)

In response to a 103(a) rejection of Claims 73-83, 85-91 & 101-112 over Checco in view of Lovett, Applicant respectfully asserts as follows.

For an obviousness rejection to be proper, the Patent Office must meet the burden of establishing a prima facie case of obviousness. The Patent Office must meet the burden of establishing that all elements of the invention are disclosed in the cited publications, which must have a suggestion, teaching or motivation for one of ordinary skill in the art to modify a reference or combined references.¹ The cited publications should explicitly provide a reasonable expectation of success, determined from the position of one of ordinary skill in the art at the time the invention was made.²

For the reasons articulated above Checco is not a 102(b)/103(a) publication and should be withdrawn as such. To the extent that Checco is at all citable against the above-mentioned Claims, Checco does not disclose TV messaging gateway *and* a messaging server, claimed as distinct and separate elements of the present invention. In Checco, a data messaging system 304 is disclosed, having a digital signal processor 404 at a communication entry point 320, an API 406, a number of calling device personality and rules sets 408, a storage for voice and data 412, and a storage input/output 410, Col. 3, lines 5-13 and Fig. 4. As disclosed on page 3 of the specification of the present application a TV messaging gateway couples the messaging server to the TV set via a message control interface. As claimed in Claim 73, the TV messaging gateway operates in conjunction with a messaging server.

In item 5 of the Office Action the Patent Office stated that "TV messaging gateway for handling messages reads on the data messaging system 304 of Checco, which supports a plurality of types of messages col. 4, lines 20-38 & col. 4, lines 45-67". In fact, the quoted portions of Checco talk

¹ *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

² *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970);

Amgen v. Chugai Pharmaceuticals Co., 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996);

Application No.: 09/484,730
Reply to Office Action of December 29, 2004
Attorney Docket No.: 0035.0001 (2000-001)

about the data messaging system and describe how each of the different peripheral devices can contact the data messaging system at a single entry point 320. If the Patent Office asserts that system 304 of Checco somehow allegedly corresponds to the TV messaging gateway as claimed in Claim 73, then the Checco patent is lacking a disclosure of the claimed messaging server. System 304 in Checco cannot be said to disclose the TV messaging gateway and the messaging server at the same time. It is even more so, since the word "server" was not found occurring in the whole text on the Checco patent even a single time.

For example, the Patent Office stated that "'TV messaging gateway adapted for operating in conjunction with a messaging server...' Checco col. 5, lines 65-67 thru col. 6, lines 1-20". The relevant lines of the Checco patent are the following (emphasis added):

FIG. 4 illustrates a block diagram of a data messaging system 304 according to a preferred embodiment of the present invention. The **data messaging system 304** includes a digital signal processor (**DSP**) 404 at a communications entry point 320, an operational API 406, a number of calling device personality and rules sets (e.g., format information) 408A-408N, at least one calling device personality and rules set for each communication device type the data messaging system handles, an input/output 410, and voice and data message storage 412.

The I/O subset provides low-level capabilities to actually store, identify, and retrieve messages from the system's storage 412. **Storage devices currently used by voice-messaging systems are limited to magnetic tape platters. But, for video-on-demand, for example, the storage device may be a laserdisc system or other large scale DASD device. Preferably, the storage device may store any type of digital data: text, video, fax, etc.**

The operational API 406 is preferably contained entirely in the data messaging system 304 and is configured to interface with replaceable, loadable personality and rules sets (PARS) modules 408A-408N

Application No.: 09/484,730
Reply to Office Action of December 29, 2004
Attorney Docket No.: 0035.0001 (2000-001)

As follows from the quoted portions of Checco, if the Patent Office meant that they describe the TV messaging gateway in conjunction with the messaging server – then the quoted portions do not disclose both elements. The Patent Office is asked to explain how both the TV messaging gateway and the messaging server are disclosed in the Checco patent.

The Patent Office also stated that “‘video output module for generating video frame signals corresponding to the message or at least a portion of the message, for distribution over the downstream to an addressable terminal,’ reads on the operation of the data system 304, including PARS 408B, which can covert any message type to still video image frames [...] col 10, lines 21-67 thru col. 11 lines 1-10.” Upon review of the quoted portion of Checco, the word “video” was not found there even a single time. The quoted portion only mentions that a fax message can be retrieved as a bitmap file for computers or as a high bandwidth still-image for viewing on a monitor connected to a set top box. Col. 11, lines 5-7. It is unclear how the Checco patent could disclose the video output module for generating video frame signals as claimed in Claim 73 without even saying in the relevant portion that it talks about video images.

The disclosure of the Lovett patent, combined by the Patent Office with the Checco patent, also does not disclose a TV messaging gateway and a messaging server as two distinct elements, claimed in Claim 73. Therefore, a combination of Checco and Lovett do not disclose the claimed elements of the invention arranged as in Claim 73. Therefore, the Patent Office has not met its burden of proof of obviousness, and such rejection should be withdrawn.

With regard to item 6 of the Office Action, the Patent Office cited Krisbergh ‘970 in combination with other patent to reject Claim 84 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krisbergh ‘970 be combinable Checco & Lovett under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Krisbergh ‘970, since that patent was not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claim 84 be allowed.

Application No.: 09/484,730
Reply to Office Action of December 29, 2004
Attorney Docket No.: 0035.0001 (2000-001)

With regard to item 7 of the Office Action, the Patent Office cited the Wagner patent in combination with other patent to reject Claim 92 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Wagner be combinable Checco & Lovett under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Wagner, since that patent was not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claim 92 be allowed.

With regard to item 8 of the Office Action, the Patent Office cited Krisbergh '970 in combination with other patent to reject Claims 92, 99 & 129-130 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krisbergh '970 be combinable Krisbergh '649 under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Krisbergh '970, since that patent was not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claims 92, 99 & 129-130.

With regard to item 9 of the Office Action, the Patent Office cited Krisbergh '970 and Krueger '075 in combination with other patent to reject Claims 94-98, 100 & 131 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krisbergh '970 be with Krisbergh '649 and Krueger under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Krisbergh '970 and Krueger, since those patents were not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claims 94-98, 100 & 131.

With regard to item 10 of the Office Action, the Patent Office cited Krisbergh '970 and Born '440 in combination with other patent to reject Claims 113 & 119 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krisbergh '970 and Born be combinable under 35 USC 103. In particular,

Application No.: 09/484,730
Reply to Office Action of December 29, 2004
Attorney Docket No.: 0035.0001 (2000-001)

Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Krisbergh '970 and Borne, since those patents were not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claims 113 & 119 be allowed.

With regard to item 11 of the Office Action, the Patent Office cited Krisbergh '970 and Born '440 in combination with other patent to reject Claim 117 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krisbergh '970 and Born '440 be combinable with Krisbergh '649 under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Krisbergh '970 and Borne, since those patents were not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claim 117 be allowed.

With regard to item 12 of the Office Action, the Patent Office cited Krisbergh '970, Krueger '075 and Born '440 to reject Claims 114-115 & 118 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krisbergh '970, Krueger '075 and Born '440 be combinable under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Krisbergh '970, Krueger and Borne, since those patents were not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claims 114-115 & 118 be allowed.

With regard to item 13 of the Office Action, the Patent Office cited Krisbergh '970 and Born '440 in combination with other patent to reject Claim 116 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krisbergh '970 and Born '440 be combinable with Checco under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Krisbergh '970 and Borne, since those patents were not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claim 116 be allowed.

Application No.: 09/484,730
Reply to Office Action of December 29, 2004
Attorney Docket No.: 0035.0001 (2000-001)

With regard to item 14 of the Office Action, the Patent Office cited Krueger '075 in combination with other patent to reject Claims 123-128 & 132-133 under 35 USC 103(a). Because of the effective filing date of the present application in the US, the Patent Office is invited to explain how can Krueger '075 be combinable with Checco under 35 USC 103. In particular, Applicant asserts that no motivation to combine, necessary to make a proper 103 finding, could be ever found with regard to Kruger, since that patent was not publicly available to one of average skill in the art at the time the application was filed. It is requested that the rejection be withdrawn and Claims 123-128 & 132-133 be allowed.

Applicant respectfully asks the Examiner to contact the undersigned to resolve any remaining questions/issues with regard to the pending Claims.

Respectfully submitted,

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